

**UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF NEW YORK**

---

PETER BIRMINGHAM and  
BIRMINGHAM SOFTHANDS INFIELD TRAINER CO., INC.

Plaintiffs,

-against-

**Civil Action No.  
5:11-cv-01135-FJS-DEP**

RAWLINGS SPORTING GOODS COMPANY, INC.,

Defendant.

**NOTICE OF  
MOTION –  
JUDGMENT ON  
THE PLEADINGS**

---

MOTION BY:	Plaintiffs Peter Birmingham and Birmingham Softhands Infield Trainer Co., Inc.
MOTION RETURN DATE:	January 27, 2012 at 10:00 AM, or such other time as this matter may be heard.
ARGUMENT:	Oral Argument Requested
SUPPORTING PAPERS:	Declaration of J. Matthew Van Ryn, Esq., with Exhibits attached thereto, Statement of Material Facts, and Memorandum of Law in Support of Motion to Dismiss
RELIEF REQUESTED:	An order pursuant to Fed. R. Civ. P. 12(c), or in the alternative pursuant to Fed. R. Civ. P. 56, for judgment on the pleadings with respect to the issue of Defendant Rawlings Sporting Goods Company, Inc.'s Failure to Meet the Summary Judgment Standard in the Cancellation Proceeding before the United State Patent & Trademark Office's Trademark Trial and Appeal Board.
ANSWERING PAPERS:	Due not less than seventeen (17) days prior to the return date for the motion.

Respectfully submitted,

Dated: December 23, 2011

By: /s/ Matthew Van Ryn

J. Matthew Van Ryn, Esq.  
MELVIN & MELVIN, PLLC  
Attorney Reg. No. 516272  
217 S. Salina St., 7<sup>th</sup> Floor  
Syracuse, NY 13202  
Phone: (315) 422-1311  
Fax: (315) 479-7612

Attorneys for Plaintiffs  
Peter Birmingham and Birmingham  
Softhands Infield Trainer Co., Inc.

UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF NEW YORK

---

PETER BIRMINGHAM and  
BIRMINGHAM SOFTHANDS INFIELD  
TRAINER CO., INC.,

Plaintiffs,

v.

RAWLINGS SPORTING GOODS CO., INC.,

Defendant.

---

**MOTION FOR JUDGMENT  
ON THE PLEADINGS  
(Fed. R. Civ. P. 12 (c))**

Civil Action No.  
5:11-cv-01135-FJS-DEP

**RELIEF SOUGHT**

Plaintiffs seek judgment on the pleadings pursuant to Fed. R. Civ. P. 12 (c) or, in the alternative, summary judgment pursuant to Fed. R. Civ. P. 56 (d), solely with respect to the issue of Defendant Rawlings Sporting Goods Company, Inc.'s (hereinafter, "Rawlings") failure to carry its burden of proof and meet the summary judgment standard in obtaining the cancellation of Plaintiffs' federally registered design trademark in Cancellation Proceeding No. 92051353 before the United States Patent & Trademark Office's Trademark Trial & Appeal Board (the "TTAB").

**GROUND FOR MOTION**

The pleadings in this action are closed and, on undisputed facts appearing from the pleadings and affidavits in support thereof, Plaintiffs Peter Birmingham and Birmingham Softhands Infield Trainer Co., Inc. are entitled to judgment as a matter of law.

In particular, the pleadings show that Defendant Rawlings Sporting Goods Company, Inc. failed to meet its burden of proof in securing cancellation of Mr. Birmingham's design trademark for the shape of a Softhands® Infield Trainer on a motion for Summary Judgment because: (a) material facts were and remain in dispute; and (b) the TTAB failed to review the pleadings and supporting materials in a light most favorable to the non-movant (see TTAB Cancellation Decision dated July 26, 2011, page 9, quoting *Old Tyme Foods, Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992)).

Specifically, the TTAB misapplied the *Inwood* formulation of the test of "*de jure* functionality" as to whether the feature of a product that is the subject of a design mark is "essential to the use or purpose of the article, or if it affects the cost or quality of the article", quoting *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844 (1982). (TTAB Cancellation Decision dated July 26, 2011, page 10).

Plaintiff / Respondent Mr. Birmingham demonstrated in the Cancellation action that the exterior shape of the Softhands® Infield Trainer is incidental to its function, and that any shape that could be cut from a 12" x 12" piece of high density foam would perform the intended function of the product equally well without affecting the functionality, manufacturing cost or quality of the product.

The TTAB clearly failed to view these facts in a light most favorable to Respondent, resulting in the decision to cancel the mark because it was considered *de jure* functional, and therefore not entitled to trademark protection under Section 2 (e)(5) of the Lanham Act (15 U.S.C. § 1052 (e)(5)). This failure by the TTAB to properly apply the summary judgment standard to the evidence before it is reversible error. Plaintiff Peter Birmingham is entitled to a reversal of the TTAB cancellation ruling as a matter of law, since Petitioner Rawlings failed to

establish either part of the *Inwood* test of *de jure* functionality – (a) that the exterior shape of the infield training pad is essential to its function, or (b) that the shape itself (and not the choice of materials) makes the product less expensive to manufacture or affects its overall quality.

Furthermore, the TTAB failed to view the allegations of the non-movant, Mr. Birmingham, in the light most favorable to Respondent, and failed to accept as true the allegations of Plaintiff / Respondent for purposes of determining Rawlings' motion for summary judgment.

### **SUPPORTING PAPERS**

This motion is based on the pleadings and papers on file in this action, this Motion, the attached Notice of Motion, the Statement of Material Facts, the supporting Memorandum of Law, the Declaration of J. Matthew Van Ryn, Esq., and whatever evidence and argument is presented at the hearing of this motion.

Respectfully submitted,

Dated: December 23, 2011

By: /s/ Matthew Van Ryn  
J. Matthew Van Ryn, Esq.  
Bar Roll No. 516272  
217 S. Salina St., 7<sup>th</sup> Floor  
Syracuse, NY 13202  
Phone: (315) 422-1311  
Fax: (315) 479-7612

Attorneys for Plaintiffs  
Peter Birmingham and Birmingham  
Softhands Infield Trainer Co., Inc.